

Serial No. 10/807,888

Dkt.: P0011111.00

Filing Date: March 24, 2004

Title: METHODS AND APPARATUS PROVIDING SUCTION-ASSISTED TISSUE ENGAGEMENT

REMARKS

The Office Action objected to the Abstract. A new Abstract is provided.

The drawings were objected to as reference character 53 was identified in the drawings but not in the specification. A replacement sheet which removes reference character 53 from Figure 4 is herein provided. A drawing correction sheet, with the correction shown in red, is also supplied for the Examiner's convenience.

Claims 1 and 3 were objected to for informalities. Those informalities are herein addressed and are believed to be moot now.

Claims 1-3 and 21 were rejected as being anticipated by U.S. Pat. No. 6,019,722 to Spence et al.

Claims 4-20 were rejected under 35 U.S.C. Section 103 (a) as being unpatentable over Spence et al in view of Boone et al. 6,464,629.

Claims 1-36 were rejected under 35 U.S.C. Section 103 (a) as being obvious over Paul et al. US 2002-0099268-A1 in view of Spence et al.

The Office Action takes the position that claims 1 – 3 and 21 were anticipated by Spence. Applicant respectfully disagrees.

Claim 1 recites, "wherein the arm vacuum lumen exhibits a vacuum leak when the articulating arm is in the flexible state, and wherein the vacuum leak is sealed as the articulating arm is changed from the flexible state to the rigid state." Claim 2 recites, "wherein the arm vacuum lumen exhibits a vacuum leak when the articulating arm is in the flexible state". Method claim 21 recites, "wherein the arm vacuum lumen exhibits a vacuum leak when the articulating arm is in the flexible state;".

None of these limitations are found in Spence. The Office Action points to O-ring seals 98. There is nothing to indicate these O-rings meet the claim language. Instead, Spence discloses that the O-rings continuously seal. As a result, it is respectfully submitted that the anticipation rejection of claims 1-3 is clearly in error and should be withdrawn.

Boone et al. does not supply the deficiencies of Spence. The Office Action points to column 10, lines 26-36 of Spence. However, there is nothing in this portion of Spence that meets the above-identified claim language. As a result, the combination of Spence and Boone fails to

Serial No. 10/807,888

Dkt.: P0011111.00

Filing Date: March 24, 2004

Title: METHODS AND APPARATUS PROVIDING SUCTION-ASSISTED TISSUE ENGAGEMENT

disclose all of the elements of the independent claims and thus, the 103 rejection should also be withdrawn.

The Office Action also took the position that all claims were obvious over Paul et al in view of Spence. Applicants agree with the statement in the Office Action that Paul et al. "does not teach an articulating arm that exhibits a vacuum leak from the arm vacuum lumen when in a flexible state and wherein the vacuum leak is sealed by changing the articulating arm into a sealed state." Applicants disagree that Spence supplies this missing teaching.

The Office Action again points to the O-rings 98 and suggests that the missing teaching is found in column 9, lines 23-35 and column 10, lines 26-36. It is simply not there. There is nothing in these passages that would suggest to one of ordinary skill in the art that Spence would meet the claim language. The rejection of all of the claims based on the combination of Paul et al in view of Spence fails because all of the limitations of the independent claims are not disclosed. As a result, it should be withdrawn.

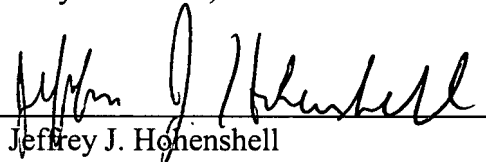
A petition for a three (3) month extension of time under 37 C.F.R. 1.136(a) has been filed with this amendment. Please charge to Deposit Account No. 13-2546 the fee of \$1,050.00 which is required for the three-month extension of time.

If the Examiner comes to believe that a telephone conversation may be useful in addressing any remaining open issues in this case, the Examiner is invited to contact the undersigned agent at 763-505-8426. **Please charge any required fees or credit any overpayment to Deposit Account No. 13-2546.**

Respectfully submitted,

Date: November 7th, 2007

By


Jeffrey J. Honenshell
Reg. No. 34,109
MEDTRONIC, INC.
710 Medtronic Parkway
Minneapolis, MN 55432
Tel.: 763-505-8426
Fax: 763-505-8436
Customer No. 27581